

Appl. No. 08/936,708  
Amdt. Dated 11/11/04  
Reply to Office Action of August 11, 2004

### REMARKS

This Amendment is in response to the Office Action mailed August 11, 2004. In the Office Action, claims 23-26, 28-29, 32-40 and 47-49 were rejected under 35 U.S.C. §102(e) as being anticipated by Arnold (U.S. Patent No. 6,160,213). Claims 27, 30 and 41-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Arnold. Applicants respectfully traverse the rejections in their entirety.

As the Examiner is aware, "[a] claim is anticipate *only if each and every* element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (Emphasis added). Applicant respectfully submits that a *prima facie* case of anticipation has not been established because Arnold fails to teach each and every element set forth in independent claims 23, 32, 40 and 47.

For instance, the Office Action states that the display featuring the plurality of tracks for a single instrument (428/430) described in Arnold constitutes the first display portion as claimed. The tracks associated with the single instrument (428/430) can be marked for recording, and when so, the current single instrument sound selected on the single instrument selection screen (200) is heard and is recorded onto the track. In contrast, with respect to claim 23, the first display portion includes a plurality of control boxes "each corresponding to one or more of a plurality of *player tracks* associated with at least one audio processing module." Emphasis added. As explicitly set forth in the specification that a record operation cannot be performed on a "player track," but rather is performed on a recorder track. *See page 10, lines 24-25 of the Specification*. Hence, the single instrument track display (428/430) of Arnold does not teach, and in fact, teaches away from the display of player tracks as claimed.

With respect to independent claims 32, 40 and 47, Applicants respectfully submit that the above-described argument similarly applies to these claims since Arnold does not teach or

080398.P109  
App. No. 08/936,708

-9-

WWS/sm  
Filed: 9/24/97

Appl. No. 08/936,708  
Amdt. Dated 11/11/04  
Reply to Office Action of August 11,2004

suggest (i) generating a first display portion including the plurality of *player tracks* (claims 32 & 47) or (ii) a processor that produces a first display portion of a graphical user interface displaying a plurality of control boxes that are adapted to control corresponding *player I/O channels* of the plurality of audio processing modules (claim 40). Emphasis added.

Based on the absence of such teachings, Applicants respectfully submit that independent claims 23, 32, 40 and 47 as well as claims 24-26, 28-29, 33-39 and 47-49 are in condition for allowance.

In addition, with respect to claim 24 for example, the Office Action contends that a global control function ("clear all") teaches the claimed subject matter of *each of the plurality of control boxes including at least one selection button* that, when selected, performs a predetermined function on *two or more of the plurality of tracks concurrently*. Emphasis added. Applicants respectfully disagree because the "clear all" function is considered by the Examiner to constitute the second display portion, not a feature of the control boxes of the first display portion as claimed. *See Page 2 of Office Action*. Moreover, with respect to recording, Arnold teaches that recording can only happen on one track. *See Column 23, lines 6-10 of Arnold*.

In light of the foregoing, Applicants respectfully request that the outstanding §102(e) rejection be withdrawn.

With respect to the outstanding §103(a) rejection, Applicants respectfully submit that Arnold does not suggest the limitations set forth above. Applicants respectfully request the Examiner to withdraw the outstanding § 103(a) rejection and invite the Examiner to contact the undersigned attorney at the phone number listed below if further discussion would facilitate prosecution of the subject Application.

080398.P109  
App. No. 08/936,708

-10-

WWS/sm  
Filed: 9/24/97

Appl. No. 08/936,708  
Amdt. Dated 11/11/04  
Reply to Office Action of August 11,2004

CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that all pending claims are in condition for allowance, and such action is respectfully solicited.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 11/11/04

By

  
William W. Schaal

Reg. No. 39,018

Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor  
Los Angeles, California 90025

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

I hereby certify that this correspondence is, on the date shown below, being:

**FACSIMILE**

**MAILING**

☐ deposited with the United States Postal Service  
as first class mail in an envelope addressed to:  
Commissioner for Patents, PO Box 1450,  
Alexandria, VA 22313-1450.

☒ transmitted by facsimile to the Patent and  
Trademark Office.

Date: 11/11/04

  
Susan McFarlane

11/11/04

Date